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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,530	02/19/2008	Curt Binner	J&J 5086	4467
27777 7590 05/22/2009 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER SU, SUSAN SHAN				
ART UNIT		PAPER NUMBER		
3761				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,530

Applicant(s)

BINNER ET AL.

Examiner

SUSAN SU

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 24 May 2007 and 27 February 2009

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Claims 1-11 & 28 in the reply filed on February 19, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)) and therefore made FINAL. Claims 12-27 have been withdrawn from consideration.

Priority

Acknowledgement is made of Applicant's claim to benefit of prior-filed Provisional Application No. 60/516,958 filed 10/31/2003.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the "annulus" for the finger recess, spirally-shaped ribs, and the core having a greater diameter proximate the withdrawal end than proximate the introduction end have not been described in the specification or shown in the drawings.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the annulus of Claim 6 and the spirally-shaped ribs must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 & 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "at least about" renders the claims indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 28 is rejected under 35 U.S.C. 102(b) for being anticipated by Johnson (US 4,212,301). Johnson teaches a method of using an absorbent tampon, the method comprising the steps of (Col. 2 lines 23-33):

- a) removing from a package, a tampon having a withdrawal end and a finger recess located in the withdrawal end;
- b) inserting a finger into the finger recess securely enough to maintain control of the tampon during insertion into a body cavity; and
- c) inserting the tampon into the body cavity.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoelling (US 2002/0151859) in view of Flam et al. (US 4,041,948, "Flam").

With regard to Claims 1 & 4, Schoelling teaches a tampon (30) comprising a fibrous absorbent body having:

- a) an insertion end (32), a withdrawal end (34), and a longitudinal axis (L);
- b) a finger recess (48) formed into the withdrawal end;
- c) a column strength ([0037] discloses that the tampon is compressed to ensure column strength);
- d) a generally uniform fiber distribution along the length of the tampon.

Schoelling does not expressly teach that the finger recess is at least 5mm deep or that the column strength is at least 10N. However, Schoelling teaches that the finger recess is provided to allow the insertion of a finger ([0040]), therefore the size of the finger recess has to accommodate a finger and one skilled in the art would be able to optimize the size of the recess.

Flam teaches a tampon made to have a column strength of at least 10N (Col. 4 lines 62-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schoelling for the purpose of allowing a user to insert the tampon with her finger and to have sufficient column strength so that the tampon can be inserted just by pushing on the withdrawal end.

With regard to Claim 2, Schoelling also teaches a cover forming an outer surface of the fibrous absorbent body ([0041], "liquid-permeable sheathing").

With regard to Claim 3, Schoelling also teaches a withdrawal string (35).

With regard to Claim 5, Schoelling and Flam do not teach that for the finger recess, the ratio of its depth to its diameter is at least 1:1. However, as explained under Claim 1, since Schoelling teaches that the finger recess is sized to allow a finger placement to aid in the insertion of the tampon, one skilled in the art would have the knowledge and desire to shape and size the finger recess so that it provides a fit over the finger such that the user can use the finger alone to insert the tampon. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schoelling and Flam for the purpose of allowing the user to easily hold on to the tampon during insertion.

With regard to Claim 7, Schoelling also teaches that the fibrous absorbent structure comprises a core (38) of relatively high fiber density substantially surrounding the longitudinal axis, from which a plurality of ribs (40) of relatively low fiber density extend radially ([0037]).

With regard to Claim 8, Schoelling also teaches that the finger recess is surrounded by the core at the withdrawal end (see Fig. 3).

With regard to Claim 9, Schoelling also teaches that the core has a greater diameter proximate the withdrawal end than proximate the introduction end (since the introduction end is rounded, there is a gradual increase in the diameter as one measures away from the tip of the introduction end).

With regard to Claim 10, Schoelling also teaches that the ribs are generally separated from adjacent ribs where they extend from the core by an open channel (42).

With regard to Claim 11, Schoelling also teaches that the ribs are spirally shaped along the tampon ([0035] and see Fig. 3).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoelling and Flam as applied to claim 1 above, and further in view of Watt et al. (EP 0 960 611, "Watt"). Schoelling and Flam do not expressly teach that the finger recess is bounded by an annulus of relatively high fiber density, which in turn is bounded by an outer region of relatively low fiber density. Watt teaches a tampon with a finger recess formed by compression of the material ([0056] and as shown in step 2 of Fig. 12), resulting in an annulus that defines the finger recess that has higher fiber density compared to the rest of the tampon. It would have been obvious to modify Schoelling and Flam with Watt for the purpose of forming a sturdy finger recess with one easy step.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN SU whose telephone number is (571)270-3848. The examiner can normally be reached on M-F 8:30AM-6:00PM EST (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Su/
Examiner, Art Unit 3761

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761